

# FAX Transmission Sheet

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Intellectual Property Practice

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## OFFICIAL BUSINESS

Date: August 31, 2004

To: Examiner: Michael J. Fisher  
Art Unit: 3629

Fax No.: 703-872-9306

From: Stephen P. Burr

Subject: U.S. Application Ser. No. 09/753,241  
Filed: December 29, 2000  
Conf. No.: 8615  
Title: PROCESS CONTROL SYSTEM AND COMPUTER READABLE  
STORAGE MEDIUM FOR STORING PROCESS CONTROL PROGRAM

Our Ref.: 892\_013

You should receive 4 page(s) including this cover sheet. If you do not receive all pages, please call (315) 233-8300.

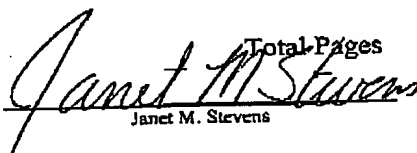
### CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following paper(s) is/are being facsimile transmitted to 703-872-9306 at the Patent and Trademark Office on August 31, 2004:

- Transmittal (in duplicate) 2 pages
- Request for Reconsideration (pages 1-4) 4 pages
- This Cover Sheet 1 page

Total Pages

7

  
Janet M. Stevens

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**TRANSMITTAL FORM**

(Provisions of 37 CFR 1.136 Apply)

Application Number	09/753,241	Filing Date	December 29, 2000	<b>RECEIVED CENTRAL FAX CENTER AUG 31 2004</b>
Group Art Unit	3629	Examiner Name	Michael J. Fisher	
Confirmation No.	8615	Attorney Docket No.	892_013	
Inventor(s)	Tateo UEGAKI			
Invention:	PROCESS CONTROL SYSTEM AND COMPUTER READABLE STORAGE MEDIUM FOR STORING PROCESS CONTROL PROGRAM			

Transmitted herewith is a Request for Reconsideration in the above-identified application. The fee has been calculated as follows:

**CLAIMS**

(1)	(2) Claims Remaining	(3)	(4) Highest Number Previously Paid	(5) No. of Extra Claims Present	(6) Rate (Large Entity)	(7) Additional Fee
TOTAL CLAIMS	9	MINUS	20	0	\$18.00	\$00.00
INDEP. CLAIMS	2	MINUS	3	0	\$86.00	\$00.00
<b>TOTAL ADDITIONAL FEE</b>						<b>\$00.00</b>

**EXTENSION OF TERM**

☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

☐ This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application. The requested extension and appropriate non-small entity fee are as follows:

- ☐ One Month (37 CFR 1.17(a)(1)) ..... \$110.00
- ☐ Two Month (37 CFR 1.17(a)(2)) ..... \$420.00
- ☐ Three Month (37 CFR 1.17(a)(3)) ..... \$950.00

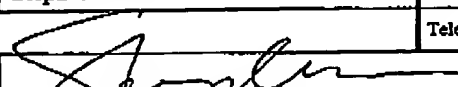
**TOTAL FEES DUE****\$00.00**

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount is reduced by one-half, and the resulting fee is:

**FEE PAYMENT**

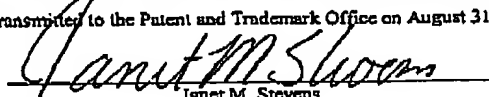
- ☒ No additional fee is required.
- ☐ A check in the amount of \$\_\_\_\_\_ is enclosed.
- ☐ Charge Deposit Account 50-1446 in the amount of \$. Enclosed is a duplicate copy of this sheet.
- ☒ Please charge any fees which may be required, or credit any overpayment, to Deposit Account 50-1446.

**Submitted By:**

Name (Print Type)	Stephen P. Burr	Reg. No.	32,970	Customer No.	025191
		Telephone	(315) 233-8300	Facsimile	(315) 233-8320
Signature				Date	August 31, 2004

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Janet M. Stevens

Practitioner's Docket No.: 892\_013

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**RECEIVED  
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In re the application of: **Tateo UEGAKI**

**AUG 31 2004**

Ser. No.: 09/753,241

Group Art Unit: 3629

Filed: December 29, 2000

Examiner: Michael J. Fisher

Confirmation No.: 8615

For: **PROCESS CONTROL SYSTEM AND COMPUTER READABLE STORAGE  
MEDIUM FOR STORING PROCESS CONTROL PROGRAM**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**CERTIFICATION OF FACSIMILE  
TRANSMISSION**

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Trademark Office on August 31, 2004.

*Janet M. Stevens*  
Janet M. Stevens

**REQUEST FOR RECONSIDERATION**

Sir:

The following remarks are in response to the Office Action mailed June 2, 2004.

Claims 1-9 are pending herein. The PTO withdrew the §102(e) rejection over Malin, but is now rejecting claims 1-9 under §103(a) over Malin. This rejection is respectfully traversed.

Before discussing the §103(a) rejection, as discussed in the March 19, 2004 Amendment, pending independent claims 1 and 9 each recite, among other things, that repair reservation determining means determines a repair-reservation based on repair-reservable day/time data stored in a repair-reserved data storage means. The repair reservation determining means rearranges repair-reservations, based on repair estimation times and waiting time periods associated with repairs, to avoid extended waiting time periods between

repair-reservations. Malin simply does not disclose or suggest a system in which extended waiting time periods between repair-reservations are advantageously avoided, as claimed.

The impetus for the PTO's §103(a) rejection is based on the belief that, in every instance, an auto mechanic's time spent working on a particular repair is charged to the customer at a flat hourly rate, regardless of the actual clock time spent working on the repair (see Office Action page 3). The PTO does not, however, cite to any portion of Malin or provide any factual evidence in support of its apparent flat hourly rate theory. The initial burden, however, is on the PTO, and not Applicant, to come forward with some factual evidence showing the specific reasons why skilled artisans would have been motivated to modify Malin's system to include the limitation that "said repair reservation determining means rearranges repair-reservations, based on repair estimation times and waiting time periods associated with repairs, to avoid extended waiting time periods between repair-reservations," as recited in pending claims 1 and 9. The PTO's conclusory statements in the Office Action cannot take the place of the required factual evidence and, therefore, the PTO has not even established a *prima facie* case of obviousness with respect to pending claims 1 and 9.<sup>1</sup> This rejection should be withdrawn for this reason alone.

Even if one were to assume that Malin's system works in accordance with the PTO's flat hourly rate billing theory, it would be abundantly clear that there would still be absolutely

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<sup>1</sup>The PTO has the burden of proving a *prima facie* case of obviousness. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993); see *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). There must be a factual basis supporting the PTO's assertion that a claimed invention is *prima facie* obvious. See *In re Lee*, 61 USPQ2d 1430, 1434 (CA FC 2002) (stating that "The Examiner's conclusory statements... [about the reasons that one would combine prior art references] do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.") When relying upon a modification of the prior art, it is incumbent upon the Examiner to identify some suggestion to make the modification. *In re Jones*, 958 F.2d 347, 351, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992); see *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 292, 227 USPQ 657, 664 (Fed. Cir. 1985).

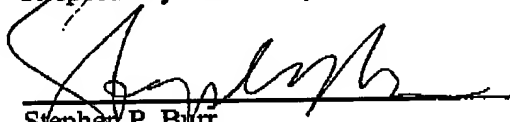
no suggestion that extended waiting time periods between repair-reservations should even be considered, let alone that such extended waiting time periods should be avoided. That is, the statement on page 3 of the Office Action that "replacing a specific part is charged according to a standard time taken, and not how long it takes a particular mechanic," would show, if anything, that "waiting time periods associated with repairs," as claimed, are not even remotely considered by Malin's system when scheduling repairs. Following the PTO's reasoning to its logical conclusion, a shop would be deemed efficient if a worker is idle between repair orders, so long as the worker's idle time is being charged to a client. The PTO's position appears to be that a shop is operating at its peak efficiency if every hour that the shop is open a client is being billed and, apparently, the amount of actual clock time that workers spend working on repair orders is completely irrelevant. The presently claimed process control system and computer readable storage medium avoids or minimizes worker down time between or during actual repair orders, which allows for shop resources to be advantageously maximized by eliminating "extended waiting time periods between repair-reservations." As such, the end result is that workers complete a higher number of repair orders, and not merely that workers find a way to charge clients for the time that they are not actually working on a repair order, as appears to be the PTO's position in the Office Action. This rejection should be withdrawn.

In view of all of the foregoing, reconsideration and withdrawal of the §103(a) rejection over Malin are respectfully requested.

If the Examiner believes that contact with Applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicant's attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1446.

Respectfully submitted,

  
\_\_\_\_\_  
Stephen P. Burr  
Reg. No. 32,970

August 31, 2004  
Date

SPB:SWC:jms

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